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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,160	06/30/2003	Yoshiko Naitoh	03560.003328.	8128

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FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER
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HUSSAIN, TAUQIR

ART UNIT	PAPER NUMBER
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2152

MAIL DATE	DELIVERY MODE
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11/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/608,160

Applicant(s)

NAITOH, YOSHIKO

Examiner

Tauqir Hussain

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5,9-11,13,15 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,9-11,13,15 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/04/2007 has been entered.

2. Claims 1, 3, 5, 9-11, 13, 15 and 19-22 are pending in this application. Claims 1, 11, 21 and 22 have been amended accordingly.

### ***Response to Arguments***

3. Applicant's arguments filed on 10/04/2007 have been fully considered but they are not deemed to be persuasive. In the remarks, applicant argued in substance that

(a) Prior art does not teach, "An updating unit configured to update the corresponding information held by the holding unit in accordance with an update notification, for updating the combination of the first device identification information and the second device identification information, from the external apparatus".

(b) Prior art does not teach, "wherein said communication controlling unit restricts issuing the information obtained from the predetermined device by said obtaining unit to the external apparatus if said determination unit determines

either the first device identification information or the second device identification information is not being managed and removes the restriction and issues the information obtained by said obtaining unit to the external apparatus if the corresponding information is updated by said updating unit".

(c) Prior art does not teach, "a communication controlling unit configured to issue a notification to an external apparatus when the determination unit determines that one of the first device identification information and the second device identification information is being managed and the other is not being managed and not to issue a notification to the external apparatus when the determination unit determines that neither one of the first device identification information and the second device identification information is being managed, the external apparatus being capable of receiving the notification through a predetermined communications line and managing a plurality of information processing apparatuses".

4. As to point (a), Schlonski in paragraph [0022] explicitly discloses, there is an updating mechanism in the server system of Schlonski that when new device is found on the network and device ID is not in the database which is same as what applicant is referring to holding unit than the entry in the database associated with the printer is added further server itself can be interpret as external apparatus which is holding the database information.

5. As to point (b), Schlonski in Fig.6, under printers\default groups\Error, lists the printers with malfunction, which becomes unmanaged until the time printer gets serviced. It is obvious that during this unmanaged time device halts most of the communication before becoming available or until error status is removed, further Yada discloses, paragraph [0012] and [0062] in view of these paragraphs it established that there will be not communications between the unmanaged device and external apparatus until the issue is resolved and therefore, no information can be passed around over the network and it is obvious that once the asset becomes manageable all other communication can be restored to have the printer related information pass around on the network.

6. As to point (c), Schlonski in paragraph [0004] discloses, "such information as would be usefully communicated between a machine and the central computer, such as network addresses, print counts, or error messages, is readily derived from the regular operations of controllers within the machine and is easily converted into a format suitable for communication to the central computer". It can be seen from the cited reference that for said network devices a communication control unit is inherent and further, Yada discloses, (Yada, paragraph [0062], where communication log means there is a communication controlling unit which analyzes the communication logs and sending a notification to administrator which is an external apparatus, which further means that system has incorporated with message notification capability in association with device management and where not sending a notification is merely a policy setup by an administrator according to business rule and paragraph [0062], where

administrator is receiving messages from the device which means there has to be a predetermined communication line installed already.

7. Any remark, which is not in claimed language, is not being considered by Examiner.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claim 1 recites the limitation as, " predefined device **capable of** performing communication over a network" in lines 2 and 18 of claim 1. The term "capable of" renders the claim indefinite as it is not sure whether device is performing or not performing and how further claim limitations will be accomplish if device fails to perform? Appropriate explanation is required.

10. Claims 1 further recites "neither one of the first device identification information and the second device..." in line 17. It seems applicant is applying double negative limitation, which means if both the devices are not managed than the invention is lacking the utility to accomplish the said limitations or it is managing something, which is not disclosed in the limitation? Appropriate explanation is required.

11. Claim 1 further recites, " said obtaining unit to the external apparatus **if** the corresponding information is updated by said updating unit" in lines 30 and 33. The

term "if" render the claim indefinite as what happens if the information is not updated?

Appropriate explanation is required.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 1,3,5,9-11,13,15,19-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yada (Pub. No.: Us 2001/0029474 A1), hereinafter "Yada" in view of Schlonski et al. (Pub. No.: US 2003/0093521 A1), hereinafter "Schlonski".

14. As to claims 1,11, 21 and 22 e.g. apparatus, method, program and storage medium, an information processing apparatus that manages a predetermined device capable of performing communication over a network (Yada, Abstract), comprising:

Yada discloses, a determination unit configured to compare a combination of the first device identification information and the second device identification information which are obtained from the predetermined device with the corresponding information held by said holding unit (Yada, paragraph [0011], where two MAC or two IP addresses are compared to match the identification information already stored in the storage content/"holding unit") and determine whether or not at least one of the first device identification information and the second device identification information is being managed (Yada, paragraph [0011], where it is determined whether assets or device has

been moved or transferred to a different location based on source and destination IP or MAC address comparison and information is updated to manage the device, which means at least one device is getting managed also read paragraph [0062] for managed device);

a communication controlling unit configured to issue a notification to an external apparatus when said determination unit determines that one of the first device identification information and the second device identification is being managed and the other is not being managed (Yada, paragraph [0062], where communication log means there is a communication controlling unit which analyzes the communication logs and sending a notification to administrator which is an external apparatus means system has incorporated with message notification capability in association with device management) and not to issue a notification to the external apparatus when said determination unit determines that neither one of the first device identification information and the second device identification information is being managed (Yada, paragraph [0062], where not sending a notification is merely a policy setup by an administrator according to business rule), the external apparatus being capable of receiving the notification through a predetermined communication line and managing a plurality of information processing apparatuses (Yada, paragraph [0062], where administrator is receiving messages from the device which means there has to be a predetermined communication line installed already); and

an updating unit configured to update the corresponding information held by the holding unit in accordance with an update notification (Yada, [0012], where



automatically update means there is an updating unit incorporated in the asset management system), for updating the combination of the first device identification information and the second device identification information, from the external apparatus (Yada, [0012], where device identification information gets updated automatically and [0062], where sending a notification to the administrator is operating an external apparatus and according to business rules device identification is updated upon receiving a notification from the newly added or any events occurred to the device e.g. device transferred to a different section);

wherein the notification issued by said communication controlling unit includes information indicating that either the first device identification information or the second device identification information is not being managed (Yada, [0062], where devices managed or not managed notification is sent to administrator), and

wherein said communication controlling unit restricts issuing the information obtained from the predetermined device by said obtaining unit to the external apparatus if said determination unit determines either the first device identification information or the second device identification information is not being managed (Yada paragraph [0012] and [0062] in view of these paragraphs it established that there will be not communications between the unmanaged device and external apparatus until the issue is resolved and therefore, no information can be passed around over the network), and removes the restriction and issues the information obtained by said obtaining unit to the external apparatus if the corresponding information is updated by said updating unit (Yada, paragraph [0062], it is obvious that once the asset becomes manageable all

other communication can be restored to have the printer related information pass around on the network).

Yada however, is silent on, a holding unit configured to hold corresponding information corresponding to first device identification information and second device identification information” or “an obtaining unit configured to obtain accounting information base on an image forming operation from the predetermined device”.

Schlonski however discloses, a holding unit configured to hold corresponding information corresponding to first device identification information and second device identification information (Schlonski, Fig.1, element-10, where devices can be first device and second device and ID's are kept in data base in element-100 further Abstract, where database is a holding unit which keeps the corresponding information to all the devices on the network which further includes first and second device identification information);

an obtaining unit configured to obtain accounting information base on an image forming operation from the predetermined device (Schlonski, Fig.1, element 100, which incorporates a database where network devices ID are stored, can be interpret as obtaining unit, [0018, lines 8-13], where print count can be interpret as accounting information based on image forming operation as depicted in Fig.5 under status history);

Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of Yada with the teachings of Schlonski in order to provide an asset management system to incorporate network

communicated devices and non-network communicated devices into one central database for enhanced inventory and asset management.

15. As to claims 3 and 13, Yada and Schlonski disclose the invention substantially as in parent claims 1 and 11, including, further comprising a receiving unit configured to receive the corresponding information from the external apparatus through the communications line (Schlonski, [0040], where asset manager is managing mutually independent or other entities meaning there has to be a communication lines setup already).

16. As to claims 5 and 15, Yada and Schlonski disclose the invention substantially as in parent claims 1 and 11, including, an inputting unit configured to input an instruction for updating the first device identification information and /or the second device identification information (Schlonski, [0025, lines 7-12], where manual entries added in the printer information properties), wherein the communication controlling unit issues a notification for update (Schlonski, [0039, lines 6-8], where discovering new network device means there has been issues a notification, based on the update instruction input by the inputting unit, to the external apparatus (Schlonski, [0025, lines 7-12], where manual entries added in the printer information properties and as explained in [0040] these devices could be from other entities or mutually independent companies).

17. As to claims 9 and 19, Yada and Schlonski disclose the invention substantially as in parent claims 1 and 11, including, wherein the first device identification is an internet

protocol address (Schlonski, [0016, lines 12-13], where IP address in the device identification).

18. As to claims 10 and 20, Yada and Schlonski disclose the invention substantially as in parent claims 9 and 19, including, wherein the second device identification information includes at least MAC address information (Schlonski, [0016, lines 15-18], where device address is a MAC address which could be second device).

19. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references, as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

### ***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tauqir Hussain whose telephone number is 571-270-1247. The examiner can normally be reached on 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571 272 3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TH  
11/12/2007

A handwritten signature in black ink, consisting of stylized, overlapping loops and a long horizontal stroke extending to the right.

BUNJOB JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER

11/13/7